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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

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1794

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,796	Applicant(s) AZAKAMI ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments in the response dated August 1, 2008.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1 – 4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chatwin et al. (USPN 5,310,222).

Chatwin et al. disclose a counterfeiting prevention label (Column 2, line 1) comprising: a base sheet (Column 6, lines 22 – 23); and a volume hologram layer covering a part of a front surface of the base sheet (Column 7, lines 1 – 4); wherein the volume hologram layer has the shape of a ribbon (Column 6, lines 3 – 9) and extends between a first end of the base sheet and a second end of the base sheet opposite the first end (Figure 1, #3), the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet (Figure 1, #3), and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet (Figure 1, #3), wherein a self-adhesive layer is formed on a back surface of the base sheet, and the adhesive layer is covered with a release sheet that is larger than the base sheet (Column 4, lines 46 – 56) as in claim 1. With regard to claim 2, the base sheet has a quadrilateral shape (Column 4, lines 46 – 56), and the volume hologram layer extends between a first side of the base sheet and a second side of the same opposite the first side (Figure 1, #3). As in claim 3, the volume hologram layer is bonded to the front surface of the base sheet with a heat-sensitive adhesive layer or a pressure-sensitive adhesive layer (Column 6, lines 23 – 30). Regarding claim 4, the surface of the volume hologram layer not facing the base sheet is coated with a protective layer (Figure 1, #6). As in claim 7, the release sheet is larger than the base sheet, the base sheet, the volume hologram layer and the self-adhesive layer form a laminated structure, a plurality of laminated structures are arranged on the release sheet, and the laminated structures have substantially the same desired shape in a plane and are spaced apart from each other (Column 4, lines 46 – 56). Regarding claim 8, characters

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are printed on the volume hologram layer and/or a part, not coated with the volume hologram layer, of the front surface of the base sheet (Column 4, lines 1 – 6).

With regard to the limitation of the hologram layer being in the shape of a ribbon, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. MPEP 2144.04. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the hologram layer. One skilled in the art would have been motivated to do so in order to change the appearance of the object to which the label is adhered.

As to claim 1, the recitation that the volume hologram is “formed by a transfer process” is a process recitation in a product. Product claims including process recitations are not limited by the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present instance, the process steps imply that the volume hologram is part of the label structure. The reference discloses such a product (Column 2, line 1).

4. Claims 1 – 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishimoto et al. (USPN 6,818,270).

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Ishimoto et al. disclose a counterfeiting prevention label (Column 1, line 7) comprising: a base sheet (Figure 2b, #14); and a volume hologram layer covering a part of a front surface of the base sheet (Figure 2b, #12); wherein the volume hologram layer has the shape of a ribbon and extends between a first end of the base sheet and a second end of the base sheet opposite the first end (Figure 2b, #12), the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet (Figure 2b, #12), and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet (Figure 2b, #12), wherein a self-adhesive layer is formed on a back surface of the base sheet (Figure 2b, #17), and the adhesive layer is covered with a release sheet that is larger than the base sheet (Figure 2b, #10) as in claim 1. With regard to claim 2, the base sheet has a quadrilateral shape (Figure 2b), and the volume hologram layer extends between a first side of the base sheet and a second side of the same opposite the first side (Figure 2b, #12). As in claim 3, the volume hologram layer is bonded to the front surface of the base sheet with a pressure-sensitive adhesive layer (Figure 2b, #17; Column 2, lines 58 – 59). Regarding claim 4, the surface of the volume hologram layer not facing the base sheet is coated with a protective layer (Figure 2b, #18).

With regard to the limitation of the hologram layer being in the shape of a ribbon, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in

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the art. MPEP 2144.04. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the hologram layer. One skilled in the art would have been motivated to do so in order to change the appearance of the object to which the label is adhered.

As to claim 1, the recitation that the volume hologram is “formed by a transfer process” is a process recitation in a product. Product claims including process recitations are not limited by the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present instance, the process steps imply that the volume hologram is part of the label structure. The reference discloses such a product (Column 1, line 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al. (USPN 5,310,222).

Chatwin et al. disclose a counterfeiting prevention label (Column 2, line 1) comprising: a base sheet (Column 6, lines 22 – 23); and a volume hologram layer covering a part of a front surface of the base sheet (Column 7, lines 1 – 4); wherein the volume hologram layer has the

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shape of a ribbon (Column 6, lines 3 – 9) and extends between a first end of the base sheet and a second end of the base sheet opposite the first end (Figure 1, #3), the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet (Figure 1, #3), and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet (Figure 1, #3), wherein a self-adhesive layer is formed on a back surface of the base sheet, and the adhesive layer is covered with a release sheet (Column 4, lines 46 – 56). However, Chatwin et al. fail to disclose a part, coated with the volume hologram layer, of the surface of the base sheet is depressed relative to a part, not coated with the volume hologram, of the surface of the base sheet to form a depression.

With regard to the limitation the surface of the base sheet is depressed relative to a part, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. MPEP 2144.04 Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the base layer. One skilled in the art would have been motivated to do so in order to change the appearance of the object to which the label is adhered.

Response to Arguments

7. Applicant's arguments filed August 1, 2008 have been fully considered but they are not persuasive.

In response to Applicant's argument that Chatwin does not disclose the volume hologram extending between a first end of the base sheet and a second end of the base sheet opposite the first end, the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet, and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet, wherein a self-adhesive layer is formed on a back surface of the base sheet, and the adhesive layer is covered with a release sheet, Chatwin does disclose the hologram extends between a first end of the base sheet and a second end of the base sheet opposite the first end (Figure 1, #3) as the entire surface of the label is covered, the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet (Figure 1, #3), and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet (Figure 1, #3) as the entire surface of the label is covered, wherein a self-adhesive layer is formed on a back surface of the base sheet, and the adhesive layer is covered with a release sheet (Column 6, lines 25 – 30).

In response to Applicant's argument that Chatwin does not disclose the volume hologram in the shape of a ribbon, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant

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unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. MPEP 2144.04. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the hologram layer. One skilled in the art would have been motivated to do so in order to change the appearance of the object to which the label is adhered in the absence of unforeseen results.

In response to Applicant's argument that Ishimoto does not disclose the volume hologram extending between a first end of the base sheet and a second end of the base sheet opposite the first end, the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet, and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet, wherein a self-adhesive layer is formed on a back surface of the base sheet, and the adhesive layer is covered with a release sheet, Ishimoto does disclose the hologram extends between a first end of the base sheet and a second end of the base sheet opposite the first end (Figure 2b, #12), the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet (Figure 2b, #12), and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet (Figure 2b, #12), wherein a self-adhesive layer is formed on a back surface of the base sheet (Figure 2b, #17), and the adhesive layer is covered with a release sheet that is larger than the base sheet (Column 8, lines 43 - 56).

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In response to Applicant's argument that Chatwin does not disclose the volume hologram in the shape of a ribbon, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. MPEP 2144.04. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the hologram layer. One skilled in the art would have been motivated to do so in order to change the appearance of the object to which the label is adhered in the absence of unforeseen results.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794